

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK LAYMANN and DIETER ROLLER

Appeal 2008-1050
Application 10/042,799
Technology Center 2100

Decided: February 3, 2009

Before: HOWARD B. BLANKENSHIP, ALLEN R. MACDONALD,
and THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

Appellants have filed a Request for Rehearing under 37 C.F.R. § 41.52(a)(1) (hereinafter “Request”) on November 24, 2008, for reconsideration of our Decision mailed September 24, 2008 (hereinafter “Decision”).

The Decision affirmed the Examiner’s rejection of claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Holmberg, Rizvi and Helmer.

We have reconsidered our Decision of September 24, 2008, in light of Appellants' comments in the Request for Rehearing, and we find no errors therein. We decline to change our prior Decision for the reasons discussed *infra*.

II. ISSUES

Appellants contend that, in our finding that the Examiner did not err in finding claims 1-14 obvious over the teachings of Homberg, Rizvi and Helmer, we have "either misapprehended and/or overlooked certain arguments presented by Appellants" (Request 2). In particular, Appellants contend that:

1. "designation as a new ground is necessary" because "Appellants have not had a fair opportunity to react to the assertion that Helmer discloses the entire limitation [of the sending step]" (Request 6);

2. "Helmer fails to yield even a single instance of the word 'database,'" and "[a]s such, Helmer does not teach the limitation of 'while the first one of the two application servers fails to access the database'" (Request 7);

3. "Helmer is silent as to the entity performing the routing of the user request to the remote server" (Request 8), but mentions the routing technique described in U.S. Patent Application No. 09/021,091, thus, Helmer much teach "the use of a redirector 16 [of 09/021,091], which is separate from an application server, that provides the routing" (Request 9); and

4. we have “essentially ignored the Examiner’s asserted motivation” (Request 14) and that we have “not properly articulated the findings necessary to establish obviousness” (Request 16).

The issue we address on this Request is whether Appellants have shown that our finding of claims 1-14 obvious over the teachings of Homberg, Rizvi and Helmer was in error. In particular, the issue turns on 1) whether designation as a new ground is necessary; 2) whether Helmer, when combined with Homberg and Rizvi, teaches or suggests “sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database” (Claim 1); and 3) whether it would have been obvious to combine the teachings of Homberg, Rizvi and Helmer.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Helmer

1. Helmer is directed to geographic data replication, wherein temporary data for a remote server is replicated to a local server. If a server fails, such as the local server, the remote server begins processing user requests based on the temporary data it received from the local server (col. 2, ll. 2-16). That is, if the local server fails, the user request is routed to the remote server, wherein the remote server processes the request with the benefit of the previously generated temporary data

(col. 2, ll. 52-55). Any routing technique may be used to route the user requests processed by the failed data center to the other data center (col. 7, ll. 35-40; fig. 1).

IV. PRINCIPLES OF LAW

All of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968) (citing *In re Boe*, 355 F.2d 961, 965 (CCPA 1966)).

A United States patent speaks for all it discloses as of its filing date, even when used in combination with other references. *In re Zenitz*, 333 F.2d 924, 926 (CCPA, 1964) (internal citations omitted).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1734 (2007).

The Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966)). The Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 1742. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.*

The Federal Circuit recently recognized that “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (citing *KSR*, 127 S. Ct. at 1739). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior art.” *Id.* at 1162 (citing *KSR*, 127 S. Ct. at 1741).

In the absence of separate arguments with respect to claims subject to the same rejection, those claims stand or fall with the claim for which an argument was made. *See In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii)(2004).

V. ANALYSIS

No new ground is necessary

To address the issue of whether designation as a new ground is necessary because “Appellants have not had a fair opportunity to react” to our finding that Helmer discloses the “entire” sending step (Request 6), we must determine whether or not Appellants have had the fair opportunity to evaluate all of the disclosures of Helmer and the Examiner’s rejection using Helmer. That is, all of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the art. *See In re Lemelson*, 397 F.2d at 1009. A United States patent speaks for all it discloses as of its filing date, even when used in combination with other references. *See In re Zenitz*, 333 F.2d at 926.

During prosecution, the Examiner found that the claims are unpatentable over the combined teachings of Homberg, Rizvi and Helmer. Contrary to Appellants’ assertion that “[c]ompletely absent from the Examiner’s analysis with regard to Helmer is any mention of Helmer being used to teach the claimed ‘while the first one of the two application servers fails to access the database’ (Request 4), the Examiner finds that Helmer discloses or at the least suggests such features. In particular, regarding the “while the first application fails to access the database” limitation, the

Examiner finds “Appellant has argued that Holmberg and Rizvi fail to disclose this feature, which the examiner has previously conceded. This limitation is taught by Helmer” (Ans. 8).

The Appellants have had a fair opportunity since the Examiner’s rejection to review the entire reference of Helmer to evaluate the reference for all that it teaches or suggests, and the Examiner’s arguments set forth in the Answer. Our finding does not add any new reference to the combined teachings Homberg, Rizvi and Helmer, or any new application of Helmer for such limitation. Thus, we do not agree that our finding of Helmer, in view of combined with Homberg and Rizvi, teaches or suggests the claimed sending step requires designation as a new ground.

Accordingly, Appellants’ Request does not persuade us to modify our Decision to designate the rejection of claims 1-14 affirmed therein as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Therefore, we find Appellants’ arguments unavailing.

Helmer, when combined with Homberg and Rizvi, teaches or at the least suggests the “sending” step

To address the issue of whether Appellants have shown that our finding of Helmer, when combined with Homberg and Rizvi, teaches or suggests “sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database” (Claim 1) is in error, we give the claim its broadest reasonable interpretation. *See In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). Our analysis will not

read limitations into the claim from the specification. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). Furthermore, our analysis will be based on the combined teachings of the applied references. *See In re Merck & Co., Inc.*, 800 F.2d at 1097. We thus restate our position as set forth on pages 6-8 of our Decision.

Although Appellants contend that “Helmer fails to yield even a single instance of the word ‘database’” (Request 7), the rejection is based on the combined teachings of Homberg, Rizvi and Helmer, and nonobviousness cannot be shown by attacking the references individually.

As the Examiner finds, Homberg teaches “a database (26) which may be accessible by the two application servers (20, 21)” (Ans. 4). In fact, as Appellants admit, “there are many teachings, in a multitude of references, of operations that occur while an application server fails to access a database” (Reply Br. 4). As we set forth in our Decision, we find that an artisan would have understood “that such routing of the user request when the local server fails of Helmer occurs in various situations *including while* the local server fails to access the database” (Decision 8). Thus, we find that the subject matter as a whole would have been obvious to the artisan.

Although Appellants also contend that “Helmer is silent as to the entity performing the routing of the user request to the remote server” (Request 8), such argument is not commensurate with the claimed invention. Claim 1 does not recite any entity performing the routing of the user request, and we will not read such limitations into the claim. Claim 1 merely recites “sending a request of the application client for the first application server from the first application server to the second application server.”

Helmer discloses that, when a local server fails, the user requests processed by the failed data center are routed to the remote server (using any routing technique), and the remote server begins processing user requests based on the temporary data it received from the local server (FF 1). As we set forth in our Decision, we find that Helmer teaches, or at the least, strongly suggests, that the request is sent from the failed local server (that processed the request) to the remote server. An artisan would have understood it to be obvious to select the local server as the server from which to send the request that it processed, to the remote server, because the remote server regularly receives data from the local server.

Although Appellants argue that Helmer must teach “the use of a redirector 16 [of 09/021,091], which is separate from an application server, that provides the routing” (Request 9), such contention is without basis. As the Appellants admit, Helmer discloses that the user requests are routed “using any routing technique” (Request 8). Thus, the routing technique used by Helmer cannot be limited to such technique as Appellants contend. In fact, Appellants’ claim 1 does not even recite that the routing is done using any particular technique.

Further, even if Appellants’ claim 1 recites a particular routing technique and Helmer teaches that only such technique described by 09/021,091 may be used, the use of Helmer will not be limited to what the Helmer patentees describe as their own inventions, since the teachings of Helmer are part of the literature of the art, relevant for all they contain. See *In re Lemelson*, 397 F.2d at 1009.

Thus, we do not agree that there is error in our finding of Helmer, when combined with Homberg and Rizvi, teaches or suggests “sending a request of the application client for the first application server from the first application server to the second application server while the first one of the two application servers fails to access the database” (Claim 1). Therefore, we find Appellants’ arguments unavailing.

It Would Have Been Obvious to Combine the References

To address the issue of whether Appellants have shown there is error in our finding that it would have been obvious to combine the teachings of Homberg, Rizvi and Helmer, we must determine whether or not the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *See KSR*, 127 S. Ct. at 1734. As set forth in our Decision, obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case, and the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. *See Leapfrog*, 485 F.3d at 1161. That is, the test for obviousness is rather what the combined teachings of the references would have suggested to those of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Young*, 927 F.2d at 591.

Although the Appellants contend that our analysis is “completely different than that presented by the Examiner,” the Appellants have had a

fair opportunity to review the entire references to Homberg, Rizvi and Helmer to evaluate the references for all that they teach and what the references would have suggested to those of ordinary skill in the art. Our finding does not add any new reference to the combined teachings.

Furthermore, the references are directed to server systems, where combining the teachings to provide “a faster and more efficient backup server” as found by the Examiner (Ans. 5) would require no more than “ordinary skill and common sense” (*KSR*, 127 S. Ct. at 1742), as we set forth in our Decision. Appellants have presented no evidence that adding the teaching of sending a request is from a failed local server (that processed the request) to the remote server, as taught or suggested by Helmer, “was uniquely challenging or difficult for one of ordinary skill in the art,” nor have Appellants presented evidence that this “represented an unobvious step over the prior art.” See *Leapfrog*, 485 F.3d at 1162.

As set forth in our Decision, a person of ordinary skill will be able to fit the teachings of Holmberg, Rizvi, and Helmer together like pieces of a puzzle since the person of ordinary skill is also a person of ordinary creativity, not an automaton. See *KSR*, 127 S. Ct. at 1742. The person of ordinary skill and common sense would find it obvious to combine the teachings to provide “a faster and more efficient backup server” as found by the Examiner (Ans. 5). Appellants have not presented any evidence to indicate why it would not have been obvious to combine the references. Thus, we find that Appellants have not met the burden on appeal to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d at 985-86.

Thus, we do not agree that our finding of obviousness to combine the references is in error. Therefore, we find Appellants' arguments unavailing.

Claims 7 and 11

Although Appellants contend that claims 7 and 11 fall separately from independent claim 1 (Request 20), Appellants do not provide separate arguments. Appellants merely contend that “[w]hereas claim 1 is directed to a method, claim 7 is directed to a computer system” (App. Br. 9), which the Examiner finds containing recitation that “occurs in the preamble” (Ans. 9). In fact, Appellants admit that the limitation in claim 7 is “comparable to the limitation found in claim 1” (App. Br. 8), and that claim 11 “similarly” recite “receiving, by the second of the application servers, a request from the first application server while the first application server fails to access the database” (App. Br. 8-9).

As the Examiner finds, “[a] preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure” (Ans. 9). Further, since Appellants do not provide separate arguments regarding claims 7 and 11, and particularly provide separate arguments as to why the Examiner has erred in finding claims 7 and 11 obvious over the combined teachings of Homberg, Rizvi, and Helmer, as set forth in the Examiner’s reasoning in the rejection of claim 1, we find that claims 7 and 11 fall with claim 1. That is, in the absence of separate arguments for claims 7 and 11 subject to the same rejection as claim 1, claims 7 and 11 shall fall with the claim 1 for which an argument was made. *See In re Young*, 927 F.2d at 590

VI. CONCLUSION

We have carefully considered the arguments raised by Appellants in the Request for Rehearing, but none of these arguments are persuasive that our original Decision was in error. We are still of the view, that the invention set forth in claims 1-14 is unpatentable over the applied prior art based on the record before us in the original appeal. This Decision on Appellants' Request for Rehearing is deemed to incorporate our earlier Decision (mailed September 24, 2008) by reference. *See* 37 C.F.R. § 41.52(a)(1).

VII. DECISION

We have granted Appellants' request to the extent that we have reconsidered our Decision of September 24, 2008, but we deny the request with respect to making any changes therein.

REHEARING DENIED

msc

CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
950 PENINSULA CORPORATE CIRCLE
SUITE 3020
BOCA RATON FL 33487